REMARKS/ARGUMENTS

The undersigned would like to thank the examiner for time taken on July 8, 2004 to clarify outstanding issues remaining in the application.

1. Status of the Claims

Claims 1 through 14 are currently pending in the application and stand rejected under 35 USC §112, first paragraph, for assertedly failing to comply with the written description requirement.

2. The Rejection under 35 USC 112, First Paragraph May properly Be Withdrawn

Claims 1 through 14 were rejected under 35 USC 112, first paragraph, for assertedly lacking written descriptive support in the application. Specifically, the examiner's position is that the invention "encompasses compounds that target all forms of nucleic acid encoding human B7 protein [claims 1-14] and ICAM protein [claims 13 and 14], which includes sequences from different species, mutated sequences, polymorphic and allelic variants, sequences that have unspecified degree of identity (similarity, homology) and so forth" [Office Action, p. 3] and that one of skill in the art would conclude that the disclosure fails to provide a representative number of oligonucleotide species to support the genus.

The applicants respectfully traverse. While it is acknowledged that the compounds exemplified in the specification were designed to target specific polynucleotide sequences encoding B7-1 and/or B7-2 proteins, the applicants submit that oligonucleotide sequences disclosed would also hybridize to sequences from different species, mutated sequences, polymorphic and allelic variants, and/or sequences that have unspecified degree of identity (similarity, homology) which encode B7-1 or B7-2. Attached are BLAST searches using (i) the B7-1 polynucleotide sequence [Exhibit A] as reported by Freeman, et al., J. Immunol. (1989), 143:2714 [hereinafter "Freeman"] (see specification at page 41, lines 27-31), and (ii) the B7-2 polynucleotide [Exhibit B] described by Azuma, et al., Nature (1993) 366:76 [hereinafter "Azuma"] (see specification at page 42, lines 3-6), which demonstrate that significantly long (in terms of base length) regions are conserved in B7 species orthologs, as well as in naturally occurring variants of B7-1- and B7-2-encoding polynucleotides. Given that the present specification discloses oligonucleotides that hybridize over the full length of B7-1- and B7-2-encoding polynucleotides, one of skill in the art would

understand that certain disclosed oligonucleotides hybridize to conserved, or at least homologous, regions in other B7-encoding polynucleotides. Sequence comparison therefore, between an ortholog or variant polynucleotide and the Freeman B7-1-encoding sequence or the Azuma B7-2-encoding sequence indicates which of the disclosed oligonucleotides can also target the ortholog or variant.

However, in an effort to expedite prosecution of the instant application, applicants have amended claim 1 herein, without prejudice to the applications right to pursue claims of the same or similar original scope in a continuing application, to recite the specific B7-1-encoding polynucleotide as described by Freeman (specification at page 41, lines 27-31) and B7-2-encoding polynucleotide described by Azuma (specification at page 42, lines 3-6), thereby obviating the rejection as it applies to claims 1 though 12. In addition, applicants have cancelled claims 13 and 14, also without prejudice to the applications right to pursue claims of the same or similar scope in a continuing application thereby obviating the examiner's rejection, thereby obviating the rejection as it applies to these claims. Accordingly, the rejection of claims under 35 USC 112, first paragraph, may properly be withdrawn.

3. Additional Remarks

During the above-noted telephone conversation on July 8, 2004, the examiner indicated that an obviousness-type double patenting rejection over claims in USSN 10/444,206 was inadvertently overlooked in the present Office Action and that such a rejection could be expected. The applicants submit that such a rejection, though not of record to date, would be improper.

An obviousness-type double patenting rejection between two co-pending utility applications must be "provisional" in nature until one of the two patents actually issues, regardless of whether the applications claim the same or different inventions. MPEP 804; see in particular Charts I-A and I-B. For example, allowance and issuance of claims in the present application could, if appropriate at the time, allow for such a rejection in USSN 10/444,206 prior to issuance of claims. Accordingly, a "non-provisional" rejection of this type is only proper in the second-to-issue application.

Moreover, the examiner's proposed rejection is based on the instant utility application and a second application, USSN 10/444,206, which was converted from a utility to

a provisional application in a paper submitted March 9, 2004, a copy of which is attached as Exhibit C. Applicants note that the Patent Office PAIR system does not indicate that this paper has been recorded (see File History printout, Exhibit D). Assuming that the requested conversion of USSN 10/444,206 is eventually made of record, that provisional application, by definition, will never issue as a patent. Accordingly, no provisional application can serve as the basis for a proper obviousness-type double patenting rejection.

4. Conclusion

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. According, the Examiner is respectfully requested to pass this application to issue.

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Respectfully submitted,

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